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--17. The method according to claim 12, wherein the chitosan has an average molecular weight of from 100,000 to 1,000,000 and a degree of deacetylation of > 55 to 99%. --

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CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time,

Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

New claims 16 and 17 are supported by the specification at page 5, lines 14-19. No new matter has been added.

Claims 4-7 and 12-15 were rejected under 35 USC § 102(b) as being anticipated by FR

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2,667,072. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. Also, if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference.

*Id.*

The instant claims expressly require that the chitosan has an average molecular weight of from 10,000 to 2,000,000 g/mol. Dependent claims 5, 12, 15 and 16 are even more specific. The Examiner's points especially to the reference's abstract and examples on page 11, but it is not *necessarily* the case that the chitosan disclosed there is the same as the chitosan required by the present claims. Accordingly, there is no inherent identity between the chitosans of the reference and those required by the present claims.

Indeed, Applicants point out that the reference in the abstract and on page 11 does not discuss the molecular weight of the chitosan that is used. However, in the third paragraph on

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page 4, it is taught that the chitosan "has a molecular mass running from the molecular mass of the oligomer to polymers having a molecular mass above 5,000." In view of these teachings of the reference, Applicants submit that there is absolutely no good reason to believe that the chitosan mentioned in the reference, particularly in the abstract and in the examples on page 11, is identical to the chitosan required by the instant claims.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Before turning to the remaining rejections, Applicants would remind the Examiner that the present claims are drawn to *methods of use, not compositions*. Applicants believe that the distinction must be kept squarely in mind because at points the Examiner clearly makes a case of the unpatentability of a *composition* comprising chitosan and phospholipids. See, for example, the first paragraph on page 3 of the Office Action.

To reiterate, the instant claims are drawn to a first *method* of reducing the tackiness of a cosmetic or dermatological preparation comprising specific chitosans by incorporating a phospholipid into the preparation, and to a second *method* of rendering non-tacky a cosmetic or dermatological preparation comprising specific chitosans by incorporating a phospholipid into

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the preparation. The question for obviousness then becomes whether the prior art suggests that the tackiness of such a preparation comprising such a chitosan can be reduced or eliminated by incorporating a phospholipid into the preparation.

Claims 4-7 and 12-15 were rejected under 35 USC § 103(a) as being obvious over EP 0 771 556 or Magdassi, U.S. Patent No. 5,518,736, or FR 2,667,072. In response, Applicants point out that none of the cited references expressly teaches Applicants' specific chitosans. Instead, there are only broad general references to molecular weights and degrees of deacetylation. Most importantly, although these references do combine chitosans with phospholipids, the effect of the phospholipids on the tackiness of the composition is unstated. A person having ordinary skill in the art is, thus, not led by the teachings of any of these references to the reasonable expectation that the addition of phospholipids to a cosmetic or dermatological preparation comprising the specific chitosans presently claimed would have had the effect of either reducing the tackiness of such preparation or rendering it non-tacky. Absent that expectation, Applicants submit that none of these references taken alone or in combination makes out a *prima facie* case of the obviousness of the present methods.

According to *Manual of Patent Examining Procedure* ("MPEP") § 2143:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation,

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either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The question is, absent a technical anticipation, whether there is anything in the cited prior art that would have suggested to a person having ordinary skill in the art that phospholipids could or should be added to a cosmetic or dermatological preparation comprising the specific chitosans recited in the present claims to reduce the tackiness of such preparation or to render such preparation non-tacky? Applicants submit that there is absolutely nothing in the cited references taken alone or in combination that suggests this result. If person having ordinary skill in the art were setting out to reduce or eliminate the tackiness of a cosmetic or dermatological preparation comprising the specific chitosans required by the instant claims, he or she would not have been led by these references taken alone or in combination to add phospholipids for this purpose. Accordingly, the instant methods could *not* have been *prima facie* obvious to such persons.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

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Claims 4-7 and 12-15 were rejected under 35 USC § 103(a) as being obvious over EP 0 771 556 or Magdassi, U.S. Patent No. 5,518,736, or FR 2,667,072 further in view of either JP 63211208 or JP 03074316. In response, Applicants point out that the deficiencies of the primary references are discussed above. With respect to the secondary references, Applicants point out that even if it is true that these references teach compositions characterized by low tackiness or non-tackiness, there is nothing in either reference that attributes this result to the presence of the phospholipids. Accordingly, a person having ordinary skill in the art is still left without the knowledge that adding phospholipids to a cosmetic or dermatological preparation comprising the specific chitosans required by the instant claims should have the effect of reducing the tackiness of such preparation or rendering such preparation non-tacky. Consequently, the combination of cited references still would not have rendered the present methods *prima facie* obvious to persons having ordinary skill in the art.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection also has been reconsidered and withdrawn is, therefore, earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

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Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (8 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: February 15, 2002

By

Kurt G. Briscoe